

REMARKS

In the Office Action,¹ the Examiner rejected claims 36-68 under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter; and maintained the rejection of claims 1-91 under 35 U.S.C. § 102(a) as being purportedly anticipated by International Publication No. WO 01/018674 to Maloney et al. ("*Maloney*") from the previous Office Action mailed April 3, 2006.

By this Amendment, Applicant cancels claims 17 and 52, and incorporates the subject matter thereof into their base claims 1 and 36, respectively. Applicant further amends claims 18-20 and 53-55 to maintain proper dependencies in light of the claim cancellations.

As discussed in more detail below, the claim rejections should be withdrawn and all of the claims should be allowed.

Rejection of Claims 36-68 under 35 U.S.C. § 101

Applicant respectfully traverses the rejection of claims 36-68 under 35 U.S.C. § 101 as being purportedly directed to non-statutory subject matter.

The Examiner alleges that "[t]he claims are directed to an abstract idea rather than a practical application of an abstract idea which would produce a 'useful, concrete or tangible results,'" and that "the claims fail[] to provide a practical application and is insufficient to establish a real world 'tangible' result." Office Action, pp. 2-3.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

Claims must produce a “useful, concrete and tangible result.” *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.2d 1368, 1373, 47 U.S.P.Q.2d 1596, 1601 (Fed. Cir. 1998). The Examiner apparently believes that claims 36-68 do not meet the “tangible” prong of the statutory test of *State Street*. See Office Action, p. 3. Applicant respectfully disagrees because Applicant’s claims recite tangible elements and produce tangible results.

Independent claim 36 recites tangible elements. Claim 36 recites a “system.” In an exemplary embodiment, “a system 400 may be . . . a stand-alone device (e.g., a computer or a kiosk) . . . [and] may include . . . a user profile database 430.” Specification, para. [049]; see *also* Fig. 4. In another exemplary embodiment, “system 400 may include . . . input module 520.” Specification, para. [055]; see *also* Fig. 5. “Input module 520 may be implemented with . . . an input device 522, . . . for example, a keyboard, a mouse, a disk drive, a telephone, a scanner,” etc. Specification, para. [057]. Furthermore, claim 36 recites “a data structure containing information.” “A data structure may include a read-only memory (ROM) device, random access memory (RAM) device, tape, disk drive, optical storage device,” etc. Specification, para. [040].

Independent claim 56, like claim 36, also recites a “system.” Furthermore, claim 56 recites “an interface for receiving from a user a selection.” According to Applicant’s specification, a user interface may include various tangible components. See, e.g., Specification, para. [0142]. Therefore, claims 36 and 56 recite tangible elements.

In addition, claims 36 and 56 produce tangible results. “It is for the discovery or invention of some practical method or means of **producing a beneficial result** or effect, that a patent is granted.” Interim Guidelines for Examination of Patent

Applications for Patent Subject Matter Eligibility, October 26, 2005, quoting *Corning v. Burden*, 56 U.S. 252, 268 (1854) (emphasis added). Claim 36 recites a system “for providing beauty advice,” including, among other elements, an “artificial intelligence engine [that] identif[ies] beauty advice . . . ; and an interface for conveying the identified beauty advice.” And, claim 56 recites a system “for identifying a product complementary to a selected product,” including, inter alia, an “artificial intelligence engine configured . . . to identify [from processed information] at least one product complementary to at least one user-selected product.” Therefore, claims 36 and 56 produce beneficial and tangible results.

For at least the reasons given above, claims 36 and 56 are statutory. In addition, dependent claims 37-51, 53-55, and 57-68 are also statutory for reasons similar to those given above with respect to their base claims 36 and 56. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 36-51 and 53-68 under 35 U.S.C. § 101.

Rejection of Claims 1-91 under 35 U.S.C. § 102(a)

Applicant respectfully traverses the rejection of claims 1-91 under 35 U.S.C. § 102(a) as being purportedly anticipated by *Maloney*.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” M.P.E.P. § 2131, quoting *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” M.P.E.P. § 2131, quoting

Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant submits that *Maloney* does not disclose each and every elements of Applicant's claims.

Independent claim 1, as amended, recites, among other things, "accessing a data structure . . . [that] includes . . . information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products." The Examiner alleges that *Maloney* at page 12, last 10 lines purportedly discloses the above-quoted features of claim 1, asserting that "recommending additional products is based on the feedback comprising aesthetic attributes . . . [and] [t]his implies at least the aesthetic suitability of said products." Office Action mailed April 3, 2006, p. 8. Applicant respectfully disagrees.

In *Maloney*, "[f]eedback information is collected." *Maloney*, p. 12. "As an example, [a] survey might comprise questions . . . on how the consumer **liked** the product, any **problems** encountered using the product, overall **satisfaction** for the product, and possible ways to **improve** the product." *Id* (emphasis added). "For example, . . . the feedback survey may comprise questions inquiring whether the shampoo had **too much or too little** lather, whether the cleaning level was **satisfactory**, and whether the shampoo delivered the desired **effectiveness**." *Id* (emphasis added). "[F]eedback data comprises performance and aesthetic attributes of the product. *Id*. "[P]roduct feedback information will be gathered from the consumer and possible **alternative** products will be recommended to the consumer." *Id* (emphasis added). Accordingly, *Maloney* teaches gathering feedback on a product and recommending an **alternative** product to address the consumer's dissatisfaction with

the first product. *Maloney* does not teach or suggest accessing a data structure that includes information about suitability of combining at least some beauty products with other beauty products, as recited in claim 1.

The Examiner asserts that *Maloney* “implies . . . the aesthetic suitability of said products.” Office Action mailed April 3, 2006, p. 8. Although Applicant does not necessarily agree with the Examiner’s characterization of *Maloney*, even assuming *arguendo* that *Maloney* teaches aesthetic suitability of a product, *Maloney* does not teach or suggest “information about suitability of combining . . . ,” as recited in claim 1. For at least this reason, *Maloney* does not teach or suggest each and every feature recited in claim 1. Thus, *Maloney* fails to anticipate claim 1.

Independent claims 21, 24, 36, 56, 69, and 70, although different in scope from claim 1, recite features having at least some similarity to those discussed above with respect to claim 1. For example, claim 21 recites “maintaining information about suitability of use of at least some of the plurality of beauty products with other of the plurality of beauty products”; claim 24 recites “identifying . . . at least one recommended product complementary to the at least one user-specified product using at least the information about product relationships”; claim 36 recites “a data structure . . . [that] includes . . . information about suitability of combining at least some of the plurality of beauty products with other of the plurality of beauty products”; claim 56 recites a “location for storing information about suitability of using at least one of the plurality of products with at least one other of the plurality of products”; claim 69 recites “identifying . . . a second recommended product complementary to the first product based on at least the information about relationships”; and claim 70 recites “selecting at least one

second beauty product complementary to the first beauty product based on information reflecting a relationship between the first beauty product and the second beauty product." *Maloney* fails to anticipate claims 21, 24, 36, 56, 69, and 70 for at least reasons similar to those given above with respect to claim 1. In addition, dependent claims 1-16, 18-20, 22, 23, 25-35, 37-51, 53-55, 57-68, and 71-91 are allowable over *Maloney* at least by virtue of their dependence from allowable base claims 1, 21, 24, 36, 56, and 70. Accordingly, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 1-16, 18-51, and 53-91 under 35 U.S.C. § 102(a) as being anticipated by *Maloney*.

Conclusion

Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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